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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12012004

Application Number: 09/337,096
Filing Date: June 21, 1999
Appellant(s): NICOLL ET AL.

Michael Chan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/29/2003.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 32, 39-42 and 45 been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection, which cancels the claims withdrawn from consideration, filed on 8/08/03, has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims stand or fall together is acknowledged.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) *Prior Art of Record*

"Billers benefit when the Bill's Not in The Mail", Bank Network News, v15, n8, Sept 11, 1996

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 33-36, 434 and 44 rejected under 35 U.S.C. 102 or in the alternative under 103(a) as being unpatentable over "Billers benefit when the Bill's Not in The Mail", Bank Network News, v15, n8, Sept 11, 1996.

The reference speaks to the idea of electronic bill presentment and payment. (3rd Paragraph) . Moreover, the reference teaches one embodiment of the invention to be A startup company called ATM Cardpay Corp. of Wilmington, Del. This company is said to have worked with banks, billers (see, page 2, 1st paragraph wherein one biller is said to be SothWestern Bell) and EFT (electronic funds transfer) networks in a scheme in which billers would send bills to a central site via electronic mail. Consumers would gain access to their bills by using their ATM card and personal identification number, either at an ATM or at a home computer equipped with a PIN.(6th Paragraph). Looking to the elements of the claims, the input receiving means for receiving account details, payment receiving means for receiving payment in the form of currency or credit, and control means for communicating with a remote system are each inherent to

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an ATM. While the reference does not directly teach of paying for a telephone account of a telephone user and for paying for additional service time, the ATM claimed and diagrammed in Figure 2 of the drawings and discussed in the specification is in not materially different from that of the prior art, each comprise a key board, a screen, and a cash input device. Moreover each of the ATMs communicate with the a remote system. A careful read of independent claim 43, shows that the information communicated with the remote system can be nothing more than an account number and a payment amount. At minimum the prior art inherently teaches this communication (as pointed out above, the ATM's of the prior art are said to be in communication with a central site). All the claimed limitations directed to how this information is interpreted by the remote system and how it is used by some remote system does not patentably distinguish the claimed terminal or the method of operating the self service terminal from the ATM of the prior art. The ATM of the prior art and the claimed invention each perform the same function with the same components and have the same method of use. It the alternative, based on the disclosure, it would have been obvious for one skilled in the art at the time to have modified the ATM of the prior art to have handled any or all of the telephone accounts Southwestern Bell or the like.

(11) Response to Argument

The applicant offers two arguments to rebut the denial of patentability. First, an argument is made that the prior art does not disclose or suggest "purchasing additional telephone service time" and second, the article relates to electronic bill presentment and payment of bills. As discussed in the rejection, the intended use of the telephone

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payment does not patentably distinguish the claimed self service terminal and use of said terminal from the ATM of the prior art. There is no argument whatsoever presented as to why ATM Cardplay Corp of the prior art would not equip its ATM to handle all the accounts of a major company like SouthWestern Bell. There is ample motivation in the prior art for doing this, namely convenience. With respect to purchasing of additional time as opposed to paying a bill which typically accounts for previous user time, again this limitation does not effect the communications sent from the ATM to the remote server. The claims must be read given their broadest reasonable interpretation. In the alternative, there is no alleged novelty with respect to prepaid mobile telephone service, prepaid telephone cards and prepaid mobile telephone service is so well known that it falls within the broad umbrella of telephone service taken as a whole. Naturally, for the reasons pointed out in the prior art, namely convenience, it would have been obvious for one skilled in the art to have modified the ATM of the prior art to have handled this type of account. For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Art Unit 3624

December 13, 2004


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09/337,096	06/21/1999	KENNETH A. NICOLL	7610	8518

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Please find below and/or attached an Office communication concerning this application or proceeding.